

REMARKS

In the application claims 29-39 remain pending. Claims 1-28 have been canceled without prejudice. Claim 30 has been added to provide proper dependency.

The claims presently stand rejected under 35 U.S.C. § 103 as allegedly being rendered obvious over Olsen (U.S. 6,137,479) as modified by Lu (U.S. 2003/0107552).

The reconsideration of the rejection of the claims is respectfully requested.

The claimed invention is directed to a controlling device which alternates between being a controlling device for controlling a PC, e.g., acting as a mouse, and a controlling device for controlling one or more home appliances, e.g., acting as a remote control. The controlling device of the claimed invention is caused, by a sensed condition, to automatically alternate between these two distinct and mutually exclusive controlling devices types. To this end, the claimed invention uses a sensor and associated programming to selectively enable either user interface elements that are used in connection with controlling the PC or user interface elements that are used in connection with controlling the one or more appliances.

Considering now Olsen, it is respectfully submitted that Olsen fails to disclose, teach, or suggest a controlling device which automatically alternates between two distinct and mutually exclusive controlling device types. Olsen discloses a computer mouse combined with a data storage device. While Olsen describes that, in certain embodiments, the computer mouse may also act as a remote control, Olsen fails to describe how such embodiments would be implemented.

As concerns the mouse of Olsen that is actually described, the mouse of Olsen includes a first subset of keys (28) and a second subset of keys (36). Signals generated by the first subset of keys (28) are sent to a computer (22) to cause the computer to perform a function. (Col. 4, lines 14-18). Signals generated by the second subset of keys (36) are used to store information such as telephone numbers, addresses, or appointments in the mouse

itself. (Col. 32-37). Nowhere does Olsen disclose that the first subset of keys (28) and the second subset of keys (36) are selectively enabled or disabled. Rather, it is evident that the first subset of keys (28) and the second subset of keys (36) of the mouse of Olsen *are always available to be used for their intended purpose*. This is particularly evidenced by the embodiments of Olsen illustrated in Figs. 6 and 7 and described at Col. 6, lines 34-46 where it is clear that Olsen makes no attempt to selectively enable/disable the functionality of different groups of keys, i.e., even when separated, the mouse portion continues to function as a mouse and the watch portion continues to function as a watch. Thus, in direct contrast to that which is claimed, Olsen, at best, suggests nothing more than a device that supports a mouse application and an additional application wherein the functionality associated with the mouse application and the functionality associated with the additional application **are both always available for use**.

While the rejection of the claims has asserted that Olsen discloses the claimed programming responsive to a sensor for selectively enabling either a first subset of keys (28) or a second subset of keys (36) at Col. 4, lines 23-31, it is respectfully submitted that this cited to paragraph fails to disclose, teach, or suggest either a sensor or selectively enabling subsets of keys. That Olsen fails to disclose a sensor for selectively enabling keys is particularly evidenced within the rejection of the claims as no corresponding element of Olsen was called forth which might be argued to perform this function. Rather than disclose that which is claimed, this cited to paragraph of Olsen describes nothing more than the fact that a computer (30) controls the operations of the mouse (20) by executing programs stored in a data memory and responding to signals from the keypad 36.

From the foregoing, it is respectfully submitted that Olsen fails to disclose, teach, or suggest a controlling device that uses a sensor to selectively enable either a first subset of keys or a second subset of keys to thereby cause the controlling device to automatically

alternate between two distinct and mutually exclusive controlling devices types. It is therefore respectfully submitted that Olsen fails to disclose, teach, or suggest the desirability of providing a control device that can avoid inadvertent operations between a computer and home appliances.

Considering now Lu, it is respectfully submitted that Lu, like Olsen, fails to disclose, teach, or suggest using a signal generated by a sensor to selectively enable either a first subset of a plurality of user interface buttons of a controlling device that are used to transmit commands to a PC or a second subset of a plurality of user interface buttons of the controlling device that are used to transmit commands to one or more appliances. Rather, Lu discloses using a sensor to enable first and second functions of a mouse wherein *both* functions of the mouse are used to send commands *only* to the PC. In one function of the mouse, e.g., when the mouse is sensed to be on a surface, commands are transmitted to the PC which are indicative of movement of the mouse over the surface. In the other function of the mouse, e.g., when the mouse is sensed to be removed from a surface, commands are transmitted to the PC which are indicative of movement of the mouse in free space. In both cases, the signals transmitted by the mouse use the same signal format since they are intended to be received by a single fixed destination, namely, the PC. In connection with these *PC limited*, mouse functions, Lu never suggests that it would also be desirable to use a sensed location of the mouse to selectively enable one of two distinct subsets of the buttons of the mouse, let alone one subset of a plurality of buttons for use in transmitting commands to a PC and another subset of a plurality of buttons for use in transmitting commands to one or more appliances. Furthermore, since Lu is not even concerned with controlling anything other than movement of a cursor and selections on a PC screen, it will be appreciated that Lu fails to even suggest any reason to “avoid inadvertent operations between computer and home

appliances” which has been advanced as the motivation for modifying the system of Olsen in view of the disclosure within Lu.

From the foregoing, it is respectfully submitted that neither Olsen nor Lu provides the teachings necessary to support a *prima facie* case of obviousness. In this regard, the references, even when combined, fail to disclose all of the elements set forth within the claims considering each and every word thereof. For this reason it is respectfully submitted that the rejection of the claims must be withdrawn.

While the fact that the references fail to disclose all of the elements set forth with the claims is sufficient to demonstrate that the rejection of the claims must be withdrawn, it is additionally submitted that neither reference discloses, teaches, or suggests the desirability of providing a controlling device with a sensor which generates a signal indicative of a position of the controlling device relative to a surface and programming which uses the signal generated by the sensor to selectively enable either a first subset of keys used to command operations of a PC and a second subset of keys, distinct from the first subset of keys, used to command operations of one or more home appliances such that a controlling device is provided with the ability to automatically alternate between two distinct and mutually exclusive controlling devices types. By lacking such disclosure, teaching, or suggestion, it is respectfully submitted that any determination that the claims are rendered obvious based upon a combination of Olsen and Lu could only be arrived at through the impermissible use of hindsight reasoning, i.e., the impermissible using of the Applicants’ disclosure as a guide to pick and choose isolated elements from Olsen and Lu, to augment what is actually disclosed within Olsen and Lu, and to impermissibly provide the motivation for combining the elements so selected. Since it is well settled, however, that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, it is respectfully submitted that for

this still further reason the rejection of the claims must be withdrawn. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

CONCLUSION

It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Examiner is respectfully requested. Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

While it is not believed that any fees are due, the Commissioner is authorized to charge any fee deficiency to deposit account 50-2428 in the name of Greenberg Traurig.

Respectfully Submitted;



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